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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,876	10/05/2000	Yasuharu Suda	198047US0PCT	3995

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EXAMINER

FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 01/03/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/646,876

Applicant(s)
Suda

Examiner
Stephen Funk

Art Unit
2854



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 30, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-24, 26, 27, 31-40, and 42-89 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 6-24, 31-40, 42-51, and 89 is/are allowed.
- 6) ☒ Claim(s) 26, 27, and 52-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12 6) ☐ Other: _____

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The disclosure is objected to because of the following informalities: In claim 6 the period after "Mo" should be a comma. Appropriate correction is required.

Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 and 27 depend from canceled claim 25. (Note that both claims 26 and 27 would conflict with parent claim 1 as amended.)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52 and 78 - 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakayama et al. (US 6,048,654). Nakayama et al. teach the printing plate material as recited and

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the method of converting and reconvertng the material between hydrophobic and hydrophilic.

See the entire document of Nakayama et al., in particular, column 6 lines 10 - 16. Note the "ionizing" tendency of the metals.

Claims 53 - 55, 66, 67, 84, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al. With respect to claims 53 and 54 the specific contact angles and energy would have been obvious, if not inherent, to one of ordinary skill in the art to achieve the desirable differences in wettability. With respect to claim 55 the broad recitation of "a flux of energy" does not distinguish from the heating disclosed by Nakayama et al. With respect to claims 66 and 67 Nakayama et al. do not specifically disclose Fe or Ni being a compound oxide with titanium. See column 6 lines 10 - 16 of Nakayama et al., for example. However, it would have been obvious to one of ordinary skill in the art through routine experimentation to utilize Fe or Ni as a compound oxide with titanium in view of Nakayama et al. teaching the desirability of using oxides as the photocatalyst. With respect to claims 84 and 87 it is well known in the art to clean and renew printing cylinders in press.

Claims 56 - 64, 72 - 77, 81 - 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al. in view of D'Heureuse et al. (US 6,318,264). Nakayama et al. do not disclose the recited types of reconvertng processes. D'Heureuse et al. disclose either chemically and/or physically reconvertng a similar printing plate material. See column 6 lines 10 - 22 and column 10 lines 9 - 24 of D'Heureuse et al., for example. It would have been obvious to one of ordinary skill in the art to reconvert the printing plate material of Nakayama et al. with any of the

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recited reconverting processes in view of D'Heureuse as a more cost or time efficient alternative method. It is deemed that each of the light energy, electrochemical, and combination reconverting processes would have been obvious to one of ordinary skill in the art through routine experimentation to arrive at optimum renewing of the hydrophilic nature of the printing plate material.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 65, 68 - 71, 85, 86, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al. in view of Gelbart et al. (US 5,713,287). Nakayama et al. do not teach providing a coating layer over the coat layer. Gelbart et al. disclose the conventionality of providing a coating layer (17), comprising a photocatalyst, over a first coat layer (18), comprising a photocatalyst, so as to renew the coat layer. See Figures 2a - 2c, and corresponding portions in the specification, of Gelbart et al. It would have been obvious to one of ordinary skill in the art to provide the printing plate material of Nakayama et al. with a renewing coating layer over the coat layer in view of Gelbart et al. so as to quickly renew the printing plate material. With respect to claims 68 - 71 and 85 note the photocatalyst, and the relevant above discussion, of the coat layer of Nakayama et al. With respect to claims 85, 86, and 88 note that the cleaning and renewing of Gelbart et al. is performed in a printing machine.

Claim 78 is rejected under 35 U.S.C. 102(b) as being anticipated by Gelbart et al. Insofar as claim 78 only positively recites structure of an apparatus, Gelbart et al. teach a writing

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apparatus comprising a light source (14). The limitations of the plate material recited in claim 52 are not incorporated, and thus do not limit, the apparatus of claim 78.

Claims 1, 6 - 24, 31 - 40, 42 - 51, and 89 are allowed.

Claims 26 and 27 would be allowable *if* rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Applicant's arguments filed October 30, 2002 have been fully considered but they are not persuasive. Applicant's argument that Nakayama et al. only teach the dopant metals *per se* and not as an ion or oxide is not convincing in view of the specific teaching in Nakayama et al. that the metals have an ionizing tendency.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Friday, except Wednesdays, from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk
January 2, 2003



STEPHEN R. FUNK
PRIMARY EXAMINER